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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------|------------------|
| 09/620,520 | 07/20/2000 | Dorothy B. Franks | GEMS:0091 | 2920 |
| 7590 | 03/28/2006 | | EXAMINER | |
| Patrick S Yoder Suite 330 7915 FM 1960 West Houston, TX 77070 | | | MOSSER, KATHLEEN MICHELE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3715 | |

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/620,520

Applicant(s)

FRANKS ET AL.

Examiner

Kathleen Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: Requirement for Information under 35 CFR 1.105.

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DETAILED ACTION

In response to the Appeal Brief filed 12/12/2005, claims 1-28 are pending.

In view of the Appeal Brief filed on 12/12/2005, PROSECUTION IS HEREBY REOPENED. An action on the merits of the claims is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


MONICA CARTER
SUPERVISORY PATENT EXAMINER

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-14 and 23-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Regarding method claims 1-14 and 23-27, for a method claim to be statutory it must have a practical application. This practical application may be achieved by either (a)

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a practical application by physical transformation (The claimed invention "transforms" an article of physical object to a different state or thing) or (b) the procedure produces an otherwise useful, concrete and tangible result. The instantly claimed invention is not drawn to the physical transformation of any product or article and is solely related to the analysis and collection of data, thus failing the first test. The invention has an asserted utility (identifying training needs), so it is useful. There is a reasonable expectation that the results of the method can be duplicated and are substantially repeatable, thus the method is concrete. The method however, is not tied to any real-world result, and is thus not tangible. In claims 1 and 23 the end result of the method is an identification of a training need. This identification is never communicated to a user or to anything outside of the system (computer or mind of the person) that performs the method. The dependent claims, although further limiting to the independent claim, do not introduce any limitations which would give the result of the claim a real world value.

Regarding system claim 28, the claim recites a series of means plus function limitations. Each of the components is disclosed in the specification as being capable of implementation as purely a computer programming. Computer programs not claimed in combination with the structural features required to realize the functionality of the program (i.e. a computer) are considered non-statutory functional descriptive material. See "interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility", (Vol. 1300 Official Gazette, November 22, 2005).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most

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nearly connected, to make and/or use the invention. Claim 1 includes the limitation "analyzing the operation data to identify at least one operational parameter affected by operator activities with the equipment component". Similar limitations occur in each of independent claims 15, 23 and 28, and are incorporated into the dependent claims through their dependencies. The specification fails to teach how the operational parameters can be used to make such identifications. Although the specification mentions several operational parameters that may be used in the analysis, it does not show what types of operators activities may cause an effect on these parameters or how the analysis is to actually be performed. Deriving such algorithms and determining how each parameter is effected by operators activities would require undue experimentation on the part of one of ordinary skill in the art. Further, claim 5 recites that the data is representative of individual operators utilizing the equipment components. The specification makes no mention as to how the specific user of a piece of biomedical equipment is tracked or determined.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 15-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "logical" in the claims is a relative term that renders the claim indefinite. The term "logical" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Objections

4. Claims 6, 7, 9, and 10 are objected to because of the following informalities: the claims either directly or through their dependencies include the phrase "medical institution" however, claim 1 from which each either directly or indirectly depends recites the limitation "medical facility". Although it is clear

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that the phrase refers to the medical facility consistent terminology is required. Appropriate correction is required.

Response to Arguments

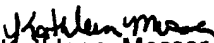
5. Applicant's arguments filed with the Appeal Brief on 12/12/2005, (see pages 9-13), with respect to Babula et al have been fully considered and are persuasive. The previous rejection of the claims has been withdrawn.

Conclusion

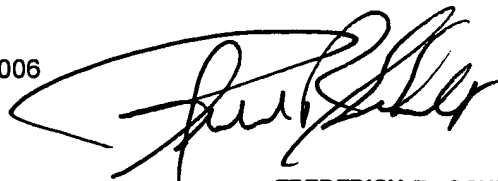
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kathleen Mosser
Primary Examiner
Art Unit 3715

February 16, 2006



**FREDERICK R. SCHMIDT
DIRECTOR
TECHNOLOGY CENTER 3700**

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Requirement for Information under 37 CFR §1.105

Attachment to office action dated 02/16/2006

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

- The information is required to extend the domain of search for prior art. Limited amounts of art related to the claimed subject matter are available within the Office, and are generally found in class 434 and subclasses 118 and 219, which describe teaching and training user on computers and computer related processes and teaching and training users to perform specific job functions. A broader range of art to search is necessary to establish the level of knowledge of those of ordinary skill in the claimed subject matter art of determine training needs and functions based upon accessed operational parameters of a biomedical device.
- The information is required to identify products and services embodying the disclosed subject matter of claim 1 and identify the properties of similar products and services found in the prior art.
- In response to this requirement, please provide copies of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of the instantly claimed invention.
- In response to this requirement, please provide the title, citation and copy of each publication that any of the applicants relied upon to develop the disclosed subject matter that describes the applicant's invention, particularly as to developing the analysis features for determining how operation data is effected by operating inputs or actions. For each publication, please provide a concise explanation of the reliance placed on that publication in the development of the disclosed subject matter.
- In response to this requirement, please provide the title, citation and copy of each publication that any of the applicants relied upon to draft the claimed subject matter. For each publication, please provide a concise explanation of the reliance placed on that publication in distinguishing the claimed subject matter from the prior art.

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- In response to this requirement, please state whether any search of prior art was performed. If a search was performed, please state the citation for each prior art collection searched. If any art retrieved from the search was considered material to demonstrating the knowledge of a person having ordinary skill in the art to the disclosed analysis features, please provide the citation for each piece of art considered and a copy of the art.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.